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Paper No. 25

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In re Application of:)
QUINN et al.)
Application No. 08/626,600)
Filed: April 2, 1996) **DECISION ON PETITION**
For: DOCUMENT STORAGE AND) **UNDER 37 CFR §1.181 AND**
RETRIEVAL SYSTEM (as amended)) **REQUEST FOR REFUND**

This is a decision on the petition filed March 4, 1999, requesting reopening prosecution following the Examiner's Answer of January 4, 1999, and a decision on the request for a refund of a one-month extension of time filed April 12, 1999.

The petition is DENIED.

The application is under Appeal from the Primary Examiner to the Board of Patent Appeals and Interferences.

The examiner issued a Final Office action on May 27, 1998 (Paper No. 12). In the action the examiner rejected claims 1-12 and 14-32 under 35 U.S.C. § 103 over Cukor et al (5,168,444) in view of Reding (an article). At page 6, lines 8-9, the examiner indicated that his position regarding Cukor et al ('444) was that Cukor discloses "means for storing messages and completed inquiries."

In response to the Final Office action, applicant filed a Notice of Appeal on August 27, 1998 (Paper No. 13), an After Final amendment on November 25, 1998 (Paper No. 17) and an Appeal Brief on November 25, 1998 (Paper No. 16). The After Final amendment made editorial changes to the disclosure but did not substantially alter what is claimed as the invention nor did it present arguments as to what is claimed as the invention. In the Appeal Brief at pages 7-9, appellant argues in regard to claims 1, 14 and 23 that Cukor et al ('444) does not teach a means to store messages and completed inquiries since the nature of what the examiner equates to be a message and inquiry in Cukor et al ('444) is not the messages and completed inquiries of the instant disclosure.

In response to the amendment and Appeal Brief, the examiner mailed an Examiner's Answer on January 4, 1999 (Paper No. 18). In the Examiner's Answer, the examiner states that the grounds of rejection is as set forth in the Final Office action. In subsections 8 and 15 of section 11 of the Examiner's Answer at pages 6-7 and 9, the examiner clarifies the rejection by stating that Cukor et al ('444) discloses storing messages and inquiries but does not specifically state that these messages and inquiries are customer messages and inquiries. Further, the examiner explains why it would have been obvious that the disclosed messages and inquiries would include customer messages and inquiries. Hence, Cukor et al ('444) discloses a means to store the claimed messages and inquiries.

In the brief in support of the instant petition, appellant alleges that the examiner has changed the grounds of rejection from 35 U.S.C. § 103 to 35 U.S.C. § 102, since the manner in which Cukor et al. ('444) has been applied is different. However, MPEP § 1208.1 states:

> "There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S. C. 103 does not constitute a new ground of rejection). Where the examiner simply changes (or adds) a rationale for supporting a rejection, but relies upon the same statutory basis and evidence in support of the rejection, there is no new ground of rejection."

As can be seen above, the instant record is clear that the examiner has clearly set forth the statutory grounds of rejection and that the grounds of rejection has not changed from the Final Rejection through the Examiner's Answer. The examiner's position has been modified to merely add clarifying rational in support of the examiner's position in response to applicant's arguments and remarks set forth in the Appeal Brief. Such a modification to clarify the examiner's position are permitted by 37 CFR §1.192(a)(2) and MPEP § 1208.1 and are not considered to be a new grounds of rejection. Hence, appellant has been given a fair an reasonable opportunity to respond to the rejection and appellant has failed to provide an adequate showing that either the statutory basis of the examiner's rejection or the thrust of the examiner's position has changed between the Final Rejection and the Examiner's Answer.

Therefore, the petition to invoke the supervisory authority of the Commissioner under 37 CFR §1.181 and reopen prosecution is **DENIED**.

The appellant filed a Request for Refund on April 12, 1999, requesting a refund of the fees paid for the petition for a one month extension of time associated with the reply brief. The petition was filed to extend the time to reply to the Examiner's Answer from March 4, 1999 to April 4, 1999. In view of the above decision, the fee paid for a one month extension was not in error as required by 37 CFR §1.26. Accordingly, the request for a refund is **DENIED**.

This application is being forwarded to the examiner for consideration of the Reply Brief filed April 2, 1999.

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